

**REMARKS****Summary of Claims**

The Office Action mailed November 30, 2004 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-8 were pending in the application. Claims 1, 3-5, 7, and 8 have been amended and no claims have been canceled or newly added. Therefore, claims 1-8 are pending in the application.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

**Title of the Invention**

In reply to the objection to the title, applicant has proposed a new title that is better indicative of the invention to which the claims are directed.

**Applied Rejections under § 112, second paragraph**

Claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In reply, applicant has amended the claims to address most of the issues raised in paragraph 2 of the Office Action.

With respect to the Office Action's assertion that the "one processing means" is indefinite in claim 1 "because it is unclear whether it refers to processing means that is currently in ready state, idle state, or sleep state," applicant notes that claim 1 does not intend to recite any specific current status of the "one" processing means. Rather, claim 1 is directed to cover the situation "when" one processing means is placed in a sleep state (irrespective of its current status) and this feature is recited in definite form. Accordingly, applicant submits that the pending claims are now in definite form and meet the requirements of 35 U.S.C. § 112, second paragraph.

**Applied Rejection under § 103**

In the Office Action, claims 1-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0126516 to Jeon (hereafter “Jeon”). Applicant respectfully traverses this rejection for at least the following reasons.

Each of the independent claims 1, 5, and 7 recite a composite apparatus (or method) that includes (1) a plurality of operationally associated processing means, such that (2) when one processing means is placed in a sleep state (a) it checks for all other processing means that are in a ready state, and (b) synchronizes the timers of all the other processing means in the ready state to the timer of the processing means placed in the sleep state.

As acknowledged in the Office Action, none of these claimed features is specifically disclosed by Jeon (the Office Action states in paragraph 3 that “Jeon does not explicitly disclose a composite apparatus comprises plurality of processing means each having an independent timer”).

Specifically, Jeon discloses controlling the shift to the sleep state, and using a timer as its technical means. The Office Action then relies on the function-performing unit (Element 12 of Fig. 1) because it teaches that the function performing unit can perform other functions. It specifically discloses the presence of other components for these additional functions, i.e., a memory, a modem, and an image processor. However, nowhere does Jeon teach the use of specific independent timers for each of the processing means (or sections) or the specifically recited synchronization between the ready timers and the timer of the one processing means (or section) that is being placed in a sleep state.

The claimed features overcomes the problem in the prior art (and in the examiner’s expanded version of Jeon) in which if each processing means is controlled completely independently, for example, after printer controller information is communicated through an external interface, even if all processing means of the digital copying machine main body are placed in a sleep state, there can occur a state in which only the printer controller enters a standby state without entering the sleep state. Therefore, even if Jeon could be extended as proposed by the Office Action to cover separate timers for different functions performed by the function performing unit 12 there is no teaching that a timer synchronization for entering

a sleep state would be performed among a plurality of operationally associated processing means as recited in the pending independent claims.

Essentially, the Office Action is using the present application's own teaching to render obvious the claimed invention when multiple claimed features are not disclosed in the applied prior art. An allegation that claimed subject matter is "obvious" (as here alleged) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO's review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966).

If, on the other hand, the PTO intended to indicate that this feature was somehow inherent in the cited reference, it should be noted that the standard for inherency requires that the feature be *necessarily present* in the prior art and not simply that it may occur or be present, i.e., be broadly included in a general or non-specific prior art teaching. See MPEP 2112 and the cases cited therein including *In Re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981) (to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill). Accordingly, applicant submits that at least this recited feature is not disclosed by the applied prior art.

Therefore, neither the specific claimed features nor their advantages are disclosed in applied prior art. Accordingly, the Office Action fails to make a *prima facie* case of obviousness with respect to the pending independent claims.

The dependent claims are also patentable for at least the same reasons as the respective independent claims on which they depend. In addition, they recite additional patentable features when considered as a whole.

### **Conclusion**

In view of the above, applicant believes that the present application is now in condition for allowance. An early notice of the same is respectfully solicited. The Examiner

is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicant hereby petitions for any needed extension of time.

Respectfully submitted,

Date February 28, 2005

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